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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,055	10/11/2001	Takeshi Shimizu	028918.01	7629
25944	7590	12/15/2004	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			HUYNH, CONG LAC T	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/974,055

Applicant(s)

SHIMIZU ET AL.

Examiner

Cong-Lac Huynh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-5 and 7-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-5, 7-9, 13, 14, 21 and 22 is/are allowed.
- 6) ☐ Claim(s) 10-12, 16-18 and 20 is/are rejected.
- 7) ☒ Claim(s) 15 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to communications: RCE filed 10/08/04 to the application filed on 10/11/01 which is a continuation of the application 08/938,973 filed on 9/26/97, now US Pat No. 6,374,271.
2. Claims 15-22 are added.
3. Claims 2-5, 7-22 are pending in the case. Claims 2, 7, 10, and 13 are the independent claims.
4. The rejection of claims 10-12 under 35 U.S.C. 102 (e) as being unpatentable over Tyler has been withdrawn in view of the amendment.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 10-12, 16-17 rejected under 35 U.S.C. 102(e) as being anticipated by Gerler, Microsoft PowerPoint 97, Que Corporation December 1996, pages 9-12, 32-34, 84, 151-154, 161-166.

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Regarding independent claim 10, Gerler discloses:

- storing data in a memory (**page 84**: clip art images are stored in a memory; **pages 151-154**: the movies, videos are stored in the gallery, a type of memory storing data)
- receiving an input through a user interface (**page 84**: selecting an image or pressing Insert button is an input through a user interface; **pages 151-154**: selecting an object in the gallery and pressing Insert button is user input through a user interface)
- generating a goals outline by instantiating at least one document prototype to a selected node of the goals outline (**pages 12, 32-34**: the goals outline of the presentation is generated by instantiating one document prototype selected from a New Slide dialog box for creating a node of the goal outline)
- linking the goal outline to a presentation outline based on user inputs and the data (**page 84**: selecting an object such as an image, a sound, or a video and pressing Insert button to insert the selected object to the slides show such a linking)
- receiving external information by the controller (**pages 161-163**: recording a sound and an the narration is receiving external information)
- generating at least one card based on the external information (**page 164**: adding the sound just recorded, which is an external information, to the stored sounds for using later on shows generating one card based on the external information)

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- storing at least one generated card as data in the memory, wherein at least one of the goal outline and the presentation is linked to the card (**pages 164-166**: adding the sound just recorded to the list of sounds in PowerPoint for use shows that the recorded sound is stored in the memory, and by selecting a sound and pressing Insert button, the selected sound, which is considered as a card, is linked to the slides in the presentation and the slide outline)

Regarding claims 11 and 12, which are dependent on claim 10, Gertler discloses:

- the step of generating an imported card accepts the external information already in a desired card structure as the imported card (**page 164**: adding the sound recorded to the list of sounds shows that generating the sound, which is an external information, accepts the sound as it is)
- the step of generating an imported card translates the external information into a desired card structure (**page 164**: the sound recorded is used accompanying an animation shows that the sound is translated to be fitted into the animated form)

Regarding claim 16, which is dependent on claim 10, Gertler discloses that the document prototype includes at least on a predetermined slot type (**page 34**: each slide layout is a predetermined slot type).

Regarding claim 17, which is dependent on claim 10, Gertler discloses that the at least one predetermined slot type is linked to a corresponding card stored in the memory

(**pages 34, 84, 165**: inserting a selected image, sound, or video from the gallery into a selected slide of a predetermined type shows the link between the slide type and the corresponding data, which is a card, stored in the memory).

Regarding claim 18, which is dependent on claim 10, Gertler discloses that the link to a corresponding card is classified as mandatory, optional and user defined (**pages 34, 84, 165**: when inserting a selected data from the gallery by users to the slides, the link is considered as user defined, when selecting a presentation with a predetermined type of slides; **pages 9-11**: AutoContent Wizard shows the link to the corresponding card, which is the content stored in memory, is mandatory or optional depending on how to select the wizard at the beginning).

Regarding claim 20, which is dependent on claim 10, Gertler discloses linking at least one node of the goal outline to at least one of a node of the presentation outline and at least one card to which a node of the presentation outline is linked (**pages 34, 84, 165**: when inserting a selected data from the gallery to a slide included in the outline of the presentation, linking at least one node of the outline to a slide and the stored data in the gallery is carried out).

***Allowable Subject Matter***

7. Claims 2-5, 7-9, 13-14, 21-22 are allowed.

8. Claims 15 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

9. Applicant's arguments with respect to claims 10-12 have been considered but are moot in view of the new ground(s) of rejection.

Regarding independent claim 10, Applicants argue that Tyler does not disclose generating a goals outline by instantiating at least one document prototype to a selected node of the goals outline, receiving external information, generating at least one card based on the external information, and storing the at least one generated card as data in the memory, wherein at least one of the goals outline and the presentation is linked to the card (Remarks, page 7).

Examiner agrees.

Gertler discloses the argue features (see the rejections above).

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Boyce et al., Using Microsoft Office 97 Professional, Que Corporation October 1997, pages 489-502, 509-510, 515-516.

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DeStefano, Make Visual Basic Talk to Word, Test & Measurement World, Mar 1997, vol. 17, iss. 4, pg. 48, 4 pgs.


Falcigno et al., Home page, sweet home page: Creating a Web presence, Database, Apr 1995, vol. 18, iss. 2, pg. 20, 7 pgs.

Ebrahim (US Pat No. 5,970,505, 10/19/99, filed 3/31/97).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-4125.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Cong-Lac Huynh  
Examiner  
Art Unit 2178  
12/07/04